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Paper No. 17
EJS

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Spezielle Communications Systems, GmbH**

Serial No. 75/347,223

Carl A. Rankin of Rankin, Hill, Porter & Clark, LLP for
Spezielle Communications Systems, GmbH

Rebecca Gilbert, Trademark Examining Attorney, Law Office
113 (Odette Bonnet, Managing Attorney)

Before Seeherman, Walters and Rogers, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Spezielle Communications Systems, GmbH has appealed
from the final refusal of the Trademark Examining Attorney
to register PACTOR as a trademark for what has ultimately
been identified as

telecommunications system for use by
amateur radio operators, comprised of
electrical instrumentation and computer
software, both for transmitting and
receiving high frequency radio
transmissions using frequencies
specifically assigned to amateur radio

operators, in the telecommunications field.¹

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark PICTOR, previously registered for "radio communication system for transmitting and receiving compressed digital image data over radio links comprised of radio transmitters, radio receivers, computer hardware and computer software for use in operating such radio communication system."²

Applicant and the Examining Attorney have filed briefs;³ an oral hearing was not requested.

In determining whether there is a likelihood of confusion between two marks, we must consider all relevant factors as set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

In any likelihood of confusion analysis under Section 2(d), two of the most important considerations are the similarities or dissimilarities between the marks and the

¹ Application Serial No. 75/347,223, filed August 26, 1997, and asserting first use and first use in commerce in July 1991.

² Registration No. 1,992,480, issued August 13, 1996.

³ In its brief applicant has made certain statements as to information which is "admittedly not of record in this case." Brief, pp. 8, 18. The Examining Attorney has objected to consideration of this information. The objection is well taken, and applicant's statements regarding information on both its own web site and that of the registrant have not been considered.

similarities or dissimilarities between the goods.

Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Turning first to the goods, applicant's goods are, essentially, a telecommunications system for amateur radio operators to transmit and receive high frequency radio transmissions, while the cited registration is for a radio communication system for transmitting and receiving compressed digital image data. Applicant has attempted to distinguish the registrant's goods from its own by pointing to statements made by the registrant during the prosecution of its own application with respect to the purchasers of its products and the manner in which they are sold. However, it is well-established that the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in the cited registration, rather than what the evidence shows the goods and/or services to be. See **In re William Hodges & Co., Inc.**, 190 USPQ 47 (TTAB 1976); **Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.**, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

There is nothing inherent in the identification of the cited registration which would require that the radio communication system be sold only to the military, disaster relief organizations, etc., as applicant argues. Nor is there anything inherent in the identification that would require the system to be sold only by a direct sales force. Registrant's radio system for transmitting and receiving compressed digital images data is identified broadly so that it could be used by anyone having the need to send and receive pictures over radio links, including the amateur radio operators who are the purchasers of applicant's goods. Absent contrary evidence, it is reasonable to conclude that such systems could also be sold through internet web sites and publications targeted to amateur radio operators.

Moreover, there is a clear relationship between the goods sold by applicant and the registrant beyond the fact that both are telecommunications systems for transmitting and receiving data using radio waves. The NEXIS articles made of record by the Examining Attorney, and which applicant confirms refer to its product, describe the PACTOR system as enabling the transfer of data and e-mail messages over radio, and as capable of transmitting color graphics. Accordingly, there is an overlap or relatedness

in the nature of the data which both applicant's and the registrant's products transmit over radio waves, and an overlap in the purpose of the products.

Despite the relatedness of the goods and similarity or overlap in the consumers for the goods and the channels of trade for their distribution, we find that confusion is not likely to result because of the differences in the marks, the sophistication of the purchasers and the care with which the products are purchased.

The Examining Attorney is correct that the marks differ only in the second letter, one being PICTOR and the other PACTOR. However, because the mark PICTOR is used with a system for transmitting and receiving digital image data, the suggestiveness of PICTOR, and the phonetic and visual similarity between the mark and the word "picture," will be readily apparent. As for the mark PACTOR, the NEXIS articles show that the system is used to send data packets, and that the term was derived because it is a "Packet/Amtor hybrid." (AMTOR is the name of an operating mode.) The sophisticated consumers who are the purchasers of applicant's and the registrant's goods are likely to recognize either the derivation of the mark or, at the very least, the connection between PACTOR and data packets. Thus, the PAC portion of applicant's mark has a connotative

significance which causes the letter "A" in applicant's mark to be noted, and this in turn has an impact in terms of the appearance and the pronunciation of the mark. Accordingly, although applicant's mark and the cited mark differ only in a single vowel, that difference results in a recognizable difference in the connotation, appearance and pronunciation of the marks.

As applicant has asserted, and as the registrant stated in its own application papers, the goods at issue are not impulse purchases, but will be selected with care, after deliberation. As a result, the differences in the marks, although slight, will be recognized.

In reaching our decision that confusion is not likely, we would point out that we have not been influenced by applicant's argument that it has a right to exclude others from the use of its mark because it owns a German registration and an International Registration. Neither of these registrations gives applicant the right to exclude others from using their marks in the United States.

Nor are we influenced by applicant's assertion that there have been no instances of actual confusion. Not only do we not have access to the registrant's experience on this factor, but we have no evidence as to the extent of either applicant's or the registrant's use of their

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respective marks in the United States from which we could conclude that there has been an opportunity for confusion to occur if such confusion were likely. In this connection, we note that both applicant and the registrant are foreign entities, and the registrant obtained its registration pursuant to Section 44(e) of the Trademark Act, and therefore did not have to show any use of the mark in this country.

Decision: The refusal of registration is reversed.